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UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 5 2001

COMMISSIONER UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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In re

DECISION ON
PETITION FOR REGRADE
UNDER 37 C.F.R. § 10.7(c)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading questions 14 and 17 of the morning section and questions 1, 12, 17, 25, 28, and 36 of the afternoon section of the Registration Examination held on April 12, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 67. On May 30, 2000, petitioner requested regrading, arguing that the model answers were incorrect. On June 21, 2000, petitioner filed a supplemental request to add arguments for question 1 of the afternoon session.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO," "PTO," or "Office" are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded no point on the Examination. No credit has been awarded for morning questions 14 and 17 and afternoon questions 1, 12, 17, 25, 28, and 36. Petitioner's arguments for these questions are addressed individually below.

Morning question 14 reads as follows:

14. On August 7, 1997, practitioner Costello filed a patent application identifying Laurel, Abbot, and Hardy as inventors. Each named inventor assigned his patent rights to Burns just prior to the application being filed. Laurel and Abbot, alone, jointly invented the subject matter of independent claim 1 in the application. Hardy contributed to inventing the subject matter of claim 2. Claim 2 properly depends upon claim 1. The examiner rejected claim 1 and claim 2 under 35 U.S.C. § 102(a) as anticipated by a journal article by Allen, dated July 9, 1997. Laurel, Abbot, and Hardy are readily available to provide evidence in support of and sign an antedating affidavit under 37 C.F.R. § 1.131 showing reduction to practice of the subject matter of claims 1 and 2 prior to July 9, 1997. Which of the following may properly make an affidavit under 37 C.F.R. § 1.131 to overcome the rejection of claims 1 and 2?

- (A) Laurel and Abbot.
- (B) Laurel, Abbot, and Hardy.
- (C) Laurel, Hardy and Burns.
- (D) Burns only.
- (E) None of the above.

The model answer is choice (B).

Answer (B) is correct. MPEP 715.04. (A) is incorrect since it cannot be shown that less than all the inventors invented the subject matter of claim 2. (C) and (D) are incorrect since the assignee can make an affidavit under 37 C.F.R. § 1.131, only when it is not possible to produce the affidavit of the inventor. The facts indicate that all inventors were readily available produce the affidavit. (E) is incorrect since (B) is correct.

Petitioner argues that answer (B) is incorrect because petitioner interprets the answer (B) as each individual listed can overcome the rejection of both claims. Petitioner also argues that answer (D) is correct because Burns, the owner, is the only one that can make a 37 CFR 1.131 affidavit for both claims.

Petitioner's argument has been fully considered but is not persuasive. Petitioner incorrectly interprets that each individual listed the answer choice (B) may make an affidavit under 37 CFR 1.131 to overcome the rejection. Answer (B) lists Laurel, Abbot, and Hardy, all the inventors for the subject matters in claims 1 and 2 because all the inventors must sign the affidavit. Contrary to petitioner's statement that only Burns may make an affidavit under 37 CFR 1.131 to overcome the rejection, Burns is

an owner to the patent application. 37 CFR 1.131(a) refers to owner of the patent under reexamination. The patent application stated in the question is not a patent under reexamination, therefore Burns cannot make the affidavit unless it is not possible to produce the affidavit of the inventors. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 17 reads as follows:

17. Smith invented a laminate. In a patent application, Smith most broadly disclosed the laminate as comprising a transparent protective layer in continuous, direct contact with a light-sensitive layer without any intermediate layer between the transparent protective layer and the light-sensitive layer. The prior art published two years before the effective filing date of Smith's application included a laminate containing a transparent protective layer and a light-sensitive layer held together by an intermediate adhesive layer. Which of the following is a proper claim that would overcome a 35 U.S.C. § 102 rejection based on the prior art?

- (A) 1. A laminate comprising a transparent protective layer and a light-sensitive layer.
- (B) 1. A laminate comprising a transparent protective layer and a light-sensitive layer which is in continuous and direct contact with the transparent protective layer.
- (C) 1. A laminate comprising a transparent protective layer and a light-sensitive layer, but not including an adhesive layer.
- (D) (A) and (B).
- (E) (B) and (C).

The model answer is choice is (E).

Answer (E) is correct because (B) and (C) are correct. (A) does not overcome the prior art because the broad "comprising" language permits the laminate to include additional layers, such as an adhesive layer. MPEP 2111.03. (B) overcomes a 35 U.S.C. § 102 rejection because the claim requires a light-sensitive layer to be in continuous and direct contact with the transparent protective layer, whereas the prior art interposes an adhesive layer between the light-sensitive layer and transparent protective layer. (C) also avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim any laminate including an adhesive layer. MPEP 2173.05(i).

Petitioner argues that answer (E) is incorrect because choice (C) would be rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements.

Petitioners' arguments have been fully considered but they are not persuasive. Claim (C) avoids the prior art by using a negative limitation to particularly point out and distinctly claim that Smith does not claim a laminate including an adhesive layer. The claims are not indefinite as lack of cooperation between the elements, because the cooperation is known. The laminate comprises the transparent protective layer and the light sensitive layer, wherein one layer is upon the other. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 1 reads as follows:

1. Which of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?

- (A) In a utility case, gross sales figures accompanied by evidence as to market share.
- (B) In a utility case, gross sales figures accompanied by evidence as to the time period during which the product was sold.
- (C) In a utility case, gross sales figures accompanied by evidence as to what sales would normally be expected in the market.
- (D) In a utility case, gross sales figures accompanied by evidence of brand name recognition.
- (E) In a design case, evidence of commercial success clearly attributable to the design, and not to improved performance of the device.

The model answer is choice (D).

(D) is correct because gross sales figures must be measured against a logical standard in order to determine whether or not there is commercial success. The recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. (D), on the other hand, recites accompanying evidence which is illogical in that it does not provide a comparative basis for determining commercial success. (E) is wrong because it provides a logical basis for attributing commercial success to the design of the device, rather than the utilitarian function of the device. MPEP 716.03(b).

Petitioner argues that answers (A), (B), (C), and (D) are all equally correct, therefore credit

should be given to the answer (C). Petitioner argues that question has two prongs: (1) which answer choice isn't probative evidence of commercial success and (2) which answer choice would support a contention of non-obvious, and an answer choice would need to satisfy only one of the prongs to be correct.

Petitioner's argument has been fully considered but is not persuasive. Contrary to petitioner's statement that because more than one answer is correct, all answers should be marked as correct, the instructions specifically states that there is only one most correct answer for each question. An incorrect answer cannot be a most correct answer where at least one correct answer is shown.

The question asks "[w]hich of the following does not constitute probative evidence of commercial success to support a contention of non-obviousness?" As to petitioner's argument that (A), (B) and (C) are correct, the recitations of accompanying evidence in (A), (B), and (C) are logical in that they provide a comparative basis for determining commercial success. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 12 reads as follows:

12. Clem and Tine, while dating, invent a wedding ring programmed to chime on each wedding anniversary. Unfortunately, the romance did not last. Clem comes to you, a registered practitioner, and says that he now wants to file a patent application. Clem admits that it was partly Tine's idea. Clem further advises you that before the couple ended their relationship, Tine deceptively filed a patent application for the same wedding ring in her name alone, application No. 09/123456. Which of the following is the proper advice to give Clem in accordance with proper PTO practice and procedure?

(A) File a patent application listing Clem as the sole inventor, and the appropriate fees. Since Tine has

already filed an application for the same device as sole inventor, she cannot be listed as a co-inventor in another application for the same device. An interference must be declared to determine proper inventorship.

- (B) File a patent application listing both Clem and Tine as coinventors, and the appropriate fees. If Tine refuses to sign the declaration, Clem has to file (i) a declaration signed by him naming himself and Tine as joint inventors, (ii) a petition, and (iii) the appropriate fees.
- (C) File a protest in the PTO (prior to the mailing of a notice of allowance in Tine's application) indicating the application serial number 09/123456 and informing the PTO that Clem is a coinventor.
- (D) Advise Clem that he could save money by allowing Tine to continue to prosecute her application and then, after the patent issues, he can sue her for half of the royalties.
- (E) (B) and (C).

The model answer is choice (E).

Answer (E) is correct. Protests may be filed pursuant to 37 C.F.R. § 1.291. See MPEP § 1901.02. However, since protester may not be advised as to the outcome of protest, it behooves him to file a patent application listing both parties as co-inventors in accordance with 35 U.S.C. § 116. As to (D), since the inventorship is not correct, and was deceptively filed, the issued patent is likely to be declared invalid and he would not recover any royalties. (A) is incorrect because Clem is misrepresenting that he believes himself to be the sole inventor, whereas he has admitted that the invention "was partly Tine's idea." 37 C.F.R. § 1.56.

Petitioner argues that answer (E) is incorrect because answer (C) is not in compliance with 37 CFR 1.291. Petitioner contends that answer (C) does not provide for serving the applicant in accordance with 37 CFR 1.248.

Petitioner's arguments have been fully considered but they are not persuasive. The question asks which of the following is the proper advice to give Clem. Answer (C) set forth a proper advice to give Clem which correctly answers the question. The question did not require the proper procedure for filing the protest. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 17 reads as follows:

Please answer questions 16 and 17 based on the following facts. On February 15, 1999, Debbie conceived a unique system for humanely caging hunting dogs and automatically feeding them at appropriate times. Debbie told her husband, Ted, about her idea that night, and the two spent the next four months working regularly on the concept. Ted built a cage that implemented the concept on June 17, 1999, and tested it on his own dogs for a week. It worked perfectly for its intended purpose. The next day, Ted visited a family friend, Ginny, who happened to be a

registered practitioner, and asked her to prepare a patent application on Debbie's behalf. Ginny declined representation, explaining that she was in the middle of trial preparation and would not be able to work on the application for at least four months. Ginny gave Ted the names of a number of qualified patent practitioners, suggesting he consider retaining one of them to promptly prepare the patent application, and explained that a delay in filing the patent application could prejudice Debbie's patent rights. Ted, however, felt uncomfortable going to a practitioner he did not know personally, and did not contact any of the individuals recommended by Ginny. After Ginny had completed her trial and was back in the office, Ted visited her on December 1, 1999. At that time Ginny agreed to represent Debbie. An application was filed in the PTO within 10 days.

17. With regard to a priority contest between Debbie and Billie, which of the following statements is most correct?

- (A) To encourage prompt disclosure of inventions to the public, the PTO always awards priority to the first to file an application, in this case Billie.
- (B) Debbie will be awarded priority only if she can establish diligence for the entire time between May 14, 1999 and her actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (C) Debbie will be awarded priority only if she can establish diligence for the entire time between her conception in February 1999 and actual reduction to practice in June 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (D) Debbie will be awarded priority if she can establish diligence for the entire time between May 14, 1999 and her patent filing in December 1999, and can establish that she did not suppress, abandon or conceal the invention.
- (E) Billie must be awarded priority because his patent application established a constructive reduction to practice prior to Debbie's actual reduction to practice, even if Debbie was diligent in reducing her invention to practice.

The model answer is choice (B).

Answer (B) is correct. 35 U.S.C. § 102(g); MPEP § 2138.01; *Mahurkar v. C.R. Bard, Inc.*, 38 USPQ2d 1288 (Fed. Cir. 1996). If statement (A) was correct, there would be no need for interference proceedings. Statement (C) is incorrect because Debbie need not establish diligence for the period from February 1999 until just before Billie's conception on May 15, 1999. Statement (D) is incorrect. Debbie needs to show diligence only from May 14th to her actual reduction to practice in June. Debbie is not required to show diligence between actual reduction to practice and her subsequent constructive reduction to practice in December 1999, so long as she has not abandoned, suppressed or concealed the invention. 35 U.S.C. § 102(g). Statement (E) is inconsistent with 35 U.S.C. § 102(g).

Petitioner argues that there is no correct answer. Petitioner contends that answer (B) is incorrect

because it states that Debbie will be awarded priority only if she can establish priority 1 day before Billie's conception, while diligence need not begin until "a time just prior to when the second conceiver entered the field" which could mean 1 second.

Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (C). Furthermore, the correct answer to the question is the most correct answer and as the instruction of the examination indicates that there is only one most correct answer for each question. Accordingly, the most correct answer is answer (B) for the reasons stated above and "time just prior" has been interpreted as 1 day prior to the conception of the second inventor. It would be hard to present evidence showing diligence began "1 second" prior to when the second conceiver entered the field as suggested by the petitioner. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 25 reads as follows:

25. You filed a patent application on behalf of Smith, an employee of Fix Corporation. The application contains a power of attorney authorizing you to transact all business before the Office on behalf of Smith. After the application is filed, Smith assigns all rights in the application to Fix Corp. In which of the following situations will the power of attorney granted to you be properly revoked?

I. Joe, in-house corporate counsel at Fix Corp., but not an officer of Fix, signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a revocation of the power of attorney granted to you, to the PTO. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

II. Smith refuses to revoke the power of attorney given to you, but Snix, president of Fix Corp., signs a submission, pursuant to 37 C.F.R. 3.73(b), establishing ownership of the entire interest in the application by Fix Corp., and forwards the submission along with a Snix-signed revocation of the power of attorney granted to you, to the PTO.

III. Joe, in-house corporate counsel at Fix Corp., advises Snix, president of Fix Corp., that the assignment by Smith to Fix Corp. automatically operates as a revocation of the power of attorney granted to you, and Snix relies upon Joe's advice in good faith and takes no further action toward revoking the power of attorney. Joe is not a registered practitioner, and he has not been authorized to bind Fix Corp.

- (A) I.
- (B) II.
- (C) III.
- (D) I and II.
- (E) None of the above.

The model answer is choice (B).

Selection (B) is correct as per MPEP 324, and 402.07. The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization – an officer. In (B), the submission is signed by the President, an office having apparent authority. (I) and (III) are incorrect since Joe is neither a registered practitioner nor an officer of the company. (III) also is incorrect since the assignment by Smith to Fix does not automatically operate as a revocation of the power of attorney. 37 C.F.R. § 1.36. Thus, (A), (C), and (D) are incorrect. (E) is incorrect since (B) is correct.

Petitioner argues that (I) is also correct and therefore answer (D), the answer stating that both (I) and (II) are correct is the best answer. Petitioner contends that Joe has authority to sign on behalf of the Fix Corp. because petitioner believes that the 37 CFR 3.73(b) statement signed by Joe includes a statement to empowered Joe to sign on behalf of the assignee.

Petitioner's argument has been fully considered but is not persuasive. The statement in (I) specifically provides that (1) Joe is not an officer of Fix, (2) he is not a registered practitioner, and (3) he has **not been authorized to bind Fix Corp.** Clearly, Joe does not have authority to sign on behalf of the assignee. Furthermore, petitioner assumes additional facts not given, specifically,

the 37 CFR 3.73(b) statement signed by Joe includes a statement to empowered Joe to sign on behalf of the assignee. The instructions explicitly state do not assume any additional facts not presented in the questions. Therefore, (I) is incorrect. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 28 reads as follows:

28. Which of the following is **true**?

- (A) On appeal of a rejection of ten claims to the Board of Patent Appeals and Interferences, each appealed claim stands or falls separately as a result of appellant pointing out differences in what the claims cover.
- (B) The 2-month period for filing a petition mentioned in 37 C.F.R. § 1.181(f) is extendable under 37 C.F.R. § 1.136(a).
- (C) An examiner may enter a new ground of rejection in the examiner's answer to an applicant's appeal brief.
- (D) After filing a notice of appeal, an applicant is estopped from further prosecuting the same claims in a continuation application.
- (E) When desiring to claim foreign priority, the oath or declaration in a reissue application must claim foreign priority even though the priority claim was made in the original patent.

The model answer is choice (E).

Selection (E) is correct. See MPEP § 1414 Content of Reissue Oath/Declaration and 37 C.F.R. § 1.175(a) which states that reissue oaths/declarations must meet the requirements of 37 C.F.R. § 1.63, including 1.63(c) relating to a claim for foreign priority. As to (A), 37 C.F.R. § 1.192(c)(7) requires appellant to state that the claims do not stand or fall together. Appellant must present appropriate argument under 37 C.F.R. § 1.192(c)(8) why each claim is separately patentable. Merely pointing out differences in what the claims cover is not argument why the claims are separately patentable. MPEP § 1206, pages 1200-8 and 9. As to (B), see MPEP § 1002. As to (C), 37 C.F.R. § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. As to (D), continuation may be filed during pendency of parent.

Petitioner argues that answer (E) is not correct and there is no correct answer, therefore credit should be given to his selected answer (B). Petitioner contends that answer (E) is incorrect because the claim for foreign priority is not required to be made in the declaration or oath.

Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (B). Furthermore, 37 C.F.R. § 1.63(c) states that the oath or declaration in any application in which a claim for foreign priority is made pursuant to 37 CFR 1.55 must identify the foreign application for patent or inventors certificate on which priority is claimed and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application number, country, day, month, and year of its filing. The statement in answer (E) is correct. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 36 reads as follows:

36. Which of the following is **true**?

- (A) As a registered practitioner, it is not necessary to notify the Director of Enrollment and Discipline of your address **changes** as long as you file a change of address in each individual application for which you are responsible.
- (B) At any time the Director of Enrollment and Discipline may send out letters to registered practitioners for the purpose of ascertaining whether they wish to remain on the register and if no reply is received, without further warning, the name may be removed from the register.
- (C) A practitioner may not refuse to aid or participate in conduct that the practitioner believes to be unlawful, even though the client presents some support for an argument that the conduct is legal.

(D) Any person who passes this examination and is registered as a patent agent or patent attorney is entitled to file and prosecute patent applications and trademark registration applications before the PTO for the same client.

(E) It is permissible to give examiners gifts valued at between \$25 and \$250 so long as the gift is made after issuance of all patent applications that the practitioner or the practitioner's firm has before the Examiner.

The model answer is choice (B).

Answer (B) is correct, see 37 C.F.R. § 10.11(b), where "the names of individuals so removed will be published in the Official Gazette." The rule does not require notice to be published before the names of individuals are removed. As to (A), a practitioner must notify the Director as set forth in 37 C.F.R. § 10.11 (a). As to (C), see 37 C.F.R. § 10.84(b)(2). As to (D) registration only entitles one to practice before the USPTO in patent cases. 37 C.F.R. §§ 10.5 and 10.14(a). As to (E), see 37 C.F.R. § 10.23(c)(4)(iii) regarding improperly bestowing of any gift, favor or thing of value.

Petitioner argues that there is no correct answer to this question. Petitioner did not present any argument for his selected answer (C). Petitioner contends that the answer (B) is not correct because the phrase "[a]t any time" can't be true since the Director can't send out a letter on Federal Holidays.

Petitioner's argument has been fully considered but is not persuasive. Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The burden is on the petitioner to show that his chosen answer is the most correct answer. For this question, petitioner has not meet this burden because he did not present any argument for his chosen answer (C). Furthermore, contrary to petitioner's argument that the Director cannot send out a letter on a Federal Holiday, the Director may put a letter in a mail box on a Federal Holiday. No error in grading has been shown. Petitioner's request for credit on this question is denied.

The regrade of the petitioner's examination has been conducted fairly and without discrimination pursuant to a uniform standard using the PTO's model answers. See *Worley v.*

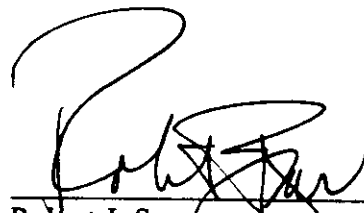
United States Patent and Trademark Office, No. 99-1469, slip op. at 4 (D.D.C. Nov. 8, 2000)(The court held that the PTO's Model Answers are a uniform standard. "[S]ince all exams are graded in reference to [the Model Answers], use of the Model Answers fosters uniformity in grading and preclude[s] unfair and individually discriminatory grading." *Id.*, slip opinion at 5. The court concluded that "the decision of the Commissioner of the USPTO not to regrade Mr. Worley's examination answers as correct when the answers did not conform with the USPTO's Model Answers was not arbitrary and capricious." *Id.*, slip opinion at 5-6.)

ORDER

For the reasons given above, no point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy